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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,617	05/14/2001	Yohnosuke Furui	JP9-2000-0025-JP1 (8728-5)	9199
22150	7590	09/08/2005	EXAMINER	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			POLLACK, MELVIN H	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/854,617

Applicant(s)

FURUI ET AL.

Examiner

Melvin H. Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached office action.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 June 2005 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection and due to the cancellation of claims 1-16.
3. The old rejections have been withdrawn in light of the cancellation of all original claims and the addition of new claims.

Claim Objections

4. Claim 22 is objected to because of the following informalities: the limitation "wherein the web page source associated with the access request (line 7)" is a sentence fragment. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 17, 20, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bienvenu et al. (6,526,438) in view of Knauff et al. (6,654,754).

7. For claims 17, 20, 22, Bienvenu teaches a system (abstract) established in a communication network (col. 1, line 1 – col. 4, line 22) comprising:

- a. A data manager (col. 5, line 65 – col. 6, line 40), for storing:
 - i. Subscriber information for a first set of paid subscribers (col. 5, lines 55-65);
 - ii. Partial subscriber information for a second set of paid subscribers (col. 5, lines 55-65), and
 - iii. Metadata describing the subscriber information for a non-paying non-subscriber (col. 5, lines 20-30);
- b. A transmission source determiner (Fig. 1, #30), for receiving an access request to the data manager from a transmission source (col. 10, lines 55-65), and for determining whether the transmission source is one of the first set of subscribers, the second set of subscribers, or the non-subscriber (Fig. 1, #32); and
- c. A response unit (Fig. 1, #36), for
 - i. If the transmission source determiner determines that the transmission source is the first set of paid subscribers, transmitting said subscriber information to the transmission source through the communication network (Fig. 1, #26),
 - ii. If the transmission source determiner determines that the transmission source is the second set of paid subscribers, transmitting said partial subscriber

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information to the transmission source through the communication network (Fig. 1, #31), and

iii. If the transmission source determiner determines that the user is one of the non-paying non-subscriber, transmitting said metadata to the transmission source through the communication network (Fig. 1, #16);

d. Wherein the subscriber information comprises full unrestricted access to an information site (col. 10, lines 15-40: full access subscribe to all publications and gain broader access rights);

e. Wherein the partial subscriber information comprises partially restricted access to the information site (col. 10, lines 15-40: partial access includes at least one but not all publications and/or some but not all access rights);

f. Wherein the non-paying non-subscriber has no access to the information site (col. 4, lines 60-62; col. 6, lines 20-25).

8. Bienvenu does not expressly disclose that metadata comprises a textual description of the subscriber information, a keyword related to the textual description for preparing a search engine keyword index, and subscription information describing how to obtain access to the subscriber information and the partial subscriber information.

9. However these differences are only found in the non-functional data stored on the article of manufacture. Data of the above types are not functionally related to the substrate of the article of manufacture. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

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10. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any data in the fields of the article of manufacture as shown in Bienvenu because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious matter of design choice. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

11. Bienvenu does not expressly disclose information regarding search engine robots. Knauff teaches a system (abstract) of providing information to search engines regarding restricted documentation (col. 1, line 1 – col. 3, line 15) comprising:

- a. A data manager (Fig. 1, #110) for storing metadata describing the subscriber information for a search engine robot (Fig. 2, #216);
- b. A transmission source determiner for determining whether the transmission source is the search engine robot (col. 5, line 65 – col. 6, line 30; col. 5, line 65 – col. 7, line 15);
- c. A response unit for if the transmission source determiner determines that the user is the search engine robot, transmitting said metadata to the transmission source through the communication network (col. 5, line 65 – col. 7, line 15);
- d. Wherein metadata comprises textual description and keywords related to the textual description for preparing a search engine keyword index (col. 6, lines 30-65).

12. At the time the invention was made, one of ordinary skill in the art would have added Knauff to Bienvenu in order to allow restricted data to be indexed (col. 2, lines 30-40), Knauff having been designed to work with restricted document systems (col. 1, line 55 – col. 2, line 5).

13. Claims 18, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bienvenu and Knauft as applied to claim 17 above, and further in view of Wyngarden (6,694,365).

14. For claim 18, Bienvenu and Knauft do not expressly disclose the details of their authentication mechanism. Wyngarden teaches a system (abstract) of providing restricted information to a user (col. 1, line 1 – col. 3, line 30) in which an information communication terminal, for accessing the information site on the communication network (Fig. 1), and for obtaining information available at said information site (Fig. 2; col. 4, lines 5-20); wherein a request for said information and identification information for said information communication terminal is transmitted to acquire said information (col. 4, lines 11-13); wherein when said information falls in an access right range that is set in accordance with said identification information, said information is provided by said information site; and wherein when said information does not fall in said access right range, metadata for describing said information is provided (col. 5, lines 25-35). At the time the invention was made, one of ordinary skill in the art would have added Wyngarden authentication processes in order to determine details of an essential feature and further in order to preserve segregated areas to maintain user access separation (col. 3, lines 15-30).

15. For claim 19, Bienvenu teaches that said metadata obtained from said information site includes text data for explaining said information (col. 8, line 65 – col. 9, line 15).

16. For claim 21, Bienvenu teaches that each access right of a user for said main information is registered in the user register (Fig. 3, #100), but does not expressly disclose that wherein when a user ID and said access request are received and registered in said user register, said

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transmission source determiner notifies said response unit of a range of said access rights of said user indicated in said user register; and wherein said response unit generates a metadata response comprising text data for describing said main information, in accordance with said range.

Wyngharden teaches these limitations, as shown in the claim 18 discussion. At the time the invention was made, one of ordinary skill in the art would have added Wyngharden authentication processes in order to determine details of an essential feature and further in order to preserve segregated areas to maintain user access separation (col. 3, lines 15-30).

17. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bienvenu and Knaft as applied to claim 22 above, and further in view of Weil et al. (6,907,423).

18. Claims 23-25 are drawn to the limitations in claim 22, but add that some search engines may be registered so as to gain more information. Bienvenu and Knaft do not expressly disclose the added limitation. Weil teaches a method (abstract) of obtaining search information from restricted content sites (col. 1, line 1 – col. 3, line 55) in which the search engines are registered (col. 8, lines 15-40) for the purpose of controlling information received by the engine (col. 5, lines 10-55). At the time the invention was made, one of ordinary skill in the art would have added Weil to Bienvenu and Knaft in order to allow selective access to content via search engine (col. 2, lines 35-45). Therefore, since claim 22 is rejected, claims 23-25 are also rejected for the reasons above.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They regard access and searching methods for restricted content sites.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal D. Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
2 September 2005


PATRICE WINDER
PRIMARY EXAMINER